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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,291	01/23/2002	Chuck Peters	60034-9085	7509

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Thompson Coburn LLP
1 Firststar CTR
Saint Louis, MO 63101

EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/055,291	Applicant(s) PETERS ET AL.	
	Examiner Minh Trinh	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/754,561.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/10/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 1-18 as amended filed on 7/19/04 are readable on the invention I, therefore all claims are now subject to being rejoined and fully examined for patentability under 37 CFR 1.104. Therefore, the restriction requirement made in the previous Office action mailed on 6/14/04 is hereby withdrawn. An Office action on the merits of claims 1-19 as follows:

Claim Objections

2. "A method" (claims 2-19, line 1) should have been: -- The method--, to reflect the dependent claim formats. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"the elongated channel" (claim 12, line 5) lacks proper antecedent basis

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Graf et al (5,137,478). Graf et al discloses the method for terminate wire to terminal comprising steps: placing sleeve 22 over the electric conductor 14 (see Figs. 1-4, and the discussed at col. 2, lines 3-4), positioning the exposed end portion of the wire 16 adjacent the terminal 24 (see Fig. 5), and securing the exposed end portion of the wire 16 to a first portion of the terminal 20 in a manner so that the exposed end portion of the wire is mechanically secured to and electrically coupled to the terminal (see Figs. 4-5), moving the sleeve a long the electric conductor to a position in which a portion of the sleeve is adjacent the terminal (see process as shown in Figs. 4-5).

Limitations of claims 15 and 19 are also met by Graf et al (see Fig. 4-5).

7. Claims 1-9 and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito (6,658,735).

As applied to claims 1, 15 and 19, Ito discloses a method for terminate wire to terminal comprising steps: placing sleeve 15 over the electric conductor e (see Figs. 1-2), positioning the exposed end portion of the wire C adjacent the terminal 10 (see Fig. 2), and securing the exposed end portion of the wire e to a first portion of the terminal 11 in a manner so that the exposed end portion of the wire e is mechanically secured to and electrically coupled to the terminal 10 (see Figs. 1-2), moving the sleeve a long the electric conductor to a position in which a portion of the sleeve is adjacent the terminal (see arrows of Fig.1).

Limitations of claims 2-9, 16-17 and 18 are also met by Ito (see Figs. 1-2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graf et al (5,137,478).

As applied to claims 1, 15 and 19, If argues that Graf et al do not teach the moving step (see claim 1, lines 11-12). It is inherent to move the sleeve a long the electric conductor to a position in which a portion of the sleeve is adjacent the terminal in order to protect the outer connection portion.

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10. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graf et al or Oto in view of Dohi (5,025,554).

Graf et al or Oto does not teach the terminal as being configurations as recited in claims 10-11. However, Dohi discloses such configurations i.e., see Fig. 3 and Fig. 5). Therefore, it would have been an obvious to one ordinary having skill in the art at the time the invention was made to employ the teaching of Dohi onto the invention of Graf or Ito in order to form a desired terminal connection having the configurations as described above. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a particular type of terminal such as one as recited in claims 10-11 since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

As applied to claim 12, it is inherently to move the sleeve in the elongated direction of the terminal.

As applied to claims 13-14, it is intended use that the conductor is part of the associated electromotive apparatus such as motor.

Prior Art References

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of connecting electric wire to a terminal or the like.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Minh Trinh
Patent Examiner Group 3700

9/15/04
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